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EXAMINER

PHAN, HUY Q

ART UNIT PAPER NUMBER

2617

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q. Phan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,8-10,16-18,20,21,25 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,8-10,16-18,20,21,25 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Amendment

2. This Office Action is in response to Amendment filed on date: 08/03/2006.
Claims 3, 5, 8-10, 16-18, 20, 21, 25, and 28-31 are still pending.

Response to Arguments

3. Applicant's arguments, see REMARKS, have been fully considered but they are not persuasive.

a) Applicant argued that "The mobile station disclosed in Bridges et al. compares the received single identity against the plurality of identities maintained on the mobile station. Consequently, the mobile station of Bridges et al. does not compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover, as recited in Applicant's amended Claim 28, and similarly recited in amended Claims 3, 8, 16, 18, 25 and 29" (see REMARKS page 12). The examiner respectfully disagrees. Bridges clearly discloses "Because some markets operate using multiple SIDs, PSLs/IRDBs will need to be administered on a per SID basis" and/or "If more than one preferred or target system exists for a given region, then the preferred

systems in an PSL/IRDB entry may be listed in order of preference and/or the air interface technology may be provided for each preferred system so that the mobile station may select the most appropriate system for that region" (see cols. 12-13). Since, Bridges also discloses "The method comprises receiving a signal transmitted by a wireless carrier containing the wireless carrier's identity, comparing the wireless carrier's identity to the database of preferred wireless carrier identities stored in the mobile station, and switching a communications mode within the mobile station so as to obtain service from the highest priority wireless carrier available" (see cols. 6-7).

Consequently, when the mobile station of Bridges is capable and/or operated using multiple SIDs, it must compare the list of multiple SIDs with the PSLs/IRDBs; therefore, the mobile station of Bridges et al. does compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover.

The examiner relies upon reference, as a whole, to anticipate the instant claims, but reference's specific citations to pinpoint pertinent passages to aid in the understandings of the reference as applied to the particular claimed elements.

b) In response to applicant's arguments that the combination of Tiedemann, Jr. and Bridges do not disclose all the limitations in claims 3 and 5 (see REMARKS page 13), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,

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231 USPQ 375 (Fed. Cir. 1986). In this particular case, Tiedemann, Jr. was used to teach all the limitations of the claims except the limitations of “the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment”. Further, Bridges was used only to teach the limitations of “the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for “the mobile may select the most appropriate system for that region”, see col. 12, lines 1-6) the first list with a second list (fig. 2C, “PSL/IRDB”) which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for “the mobile may select the most appropriate system for that region”, see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges “so as to obtain service from the highest priority wireless carrier available” (see col. 7, lines 1-5)”.

b) In response to applicant's arguments that the combination of Tiedemann, Jr. and Bridges do not disclose all the limitations in claims 3 and 5 (see REMARKS page 13), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Tiedemann, Jr. was used to teach all the limitations of the claims except the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment". Further, Bridges was used only to teach the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see

col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5)".

c) In response to applicant's arguments that the combination of Van Den Heuvel and Bridges do not disclose all the limitations in claims 16-18 and 20 (see REMARKS page 13), the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Van Den Heuvel was used to teach all the limitations of the claims except the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment". Further, Bridges was used only to teach the limitations of "the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list

(fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5)".

With all the reasons stated above, the rejection is deemed proper and still stands.

Claim Objections

4. Claim 18 is objected to because of typographical errors.

In claim 18, line 1, the second "user" should be changed to - -equipment- -.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by
Bridges (US-6,148,197).

Regarding claim 28, Bridges discloses a method of using user equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

receiving a first list including a plurality of network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and

comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one network identifier and is stored in the user equipment (see col. 8, lines 50-67) to identify at least one network for handover (col. 10, lines 20-51; for more details see fig. 2A and cols. 8-12).

Regarding claim 29, Bridges discloses user equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

means for receiving a first list including a plurality of network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and

means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one

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network identifier and is stored in the user equipment (see col. 8, lines 50-67) to identify at least one network for handover (col. 10, lines 20-51; for more details see fig. 2A and cols. 8-12).

Regarding claims 30 and 31, Bridges discloses all the limitations of the claims 28 and 29 respectively, wherein the network identifier in the second list is an identifier of a network that is not used (col. 11, lines 36-38).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. (US-5,940,761) in view of Bridges (US-6,148,197).

Regarding claim 3, Tiedemann, Jr. discloses a method of facilitating handover (fig. 2 and its description) from an active network (original system S1) with which user equipment (M1-M3) is in communication to another network (destination system S2), the method comprising the steps of:

receiving from user equipment communicating via the active network an indication of at least one preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

in response thereto, providing to the user equipment via the active network neighbor cell information for the at least one preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers; and comparing the first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment. However in analogous art, Bridges teaches the steps of transmitting to the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for (see col. 8, lines 50-67) selectively communicating with at least one of a plurality of networks, the comparison being performed by the user equipment (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 25, Tiedemann, Jr. discloses a mobile communications network (fig. 2 and its description) or component thereof including:

means for receiving from user equipment communicating with the network an indication of a preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

means for supplying neighboring cell information for the preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show means for receiving by the user equipment a first list having a plurality of unique network identifiers; and means for comparing by the User equipment the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment for selectively communicating with at least one of a plurality of networks. However, Bridges teaches means for receiving by the user equipment a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29); and means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) by the user equipment the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier

from the plurality of unique network identifiers and is internally stored in the User equipment (see col. 8, lines 50-67) for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

b) Claims 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel (US-6,223,030) in view of Bridges (US-6,148,197).

Regarding claim 16, Van Den Heuvel discloses a user equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which user equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising: means for storing a second list of available other networks supplied by the active network (fig. 6 and col. 5, lines 18-24); means for transmitting from the user equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65).

But, Van Den Heuvel does not particularly show means for receiving a first list having a plurality of unique network identifiers; and means for comparing the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment for

selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches means for receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29) and means for comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with a second list (fig. 2C, "PSL/IRDB") which includes the at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the user equipment (see col. 8, lines 50-67) for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 17, Van Den Heuvel and Bridges disclose the user equipment according to claim 16. Bridges further discloses that comprising means for updating the stored list of available other networks based on information supplied by the active network (col. 15, lines 35-45).

Regarding claim 18, Van Den Heuvel discloses a user equipment (SU 20) for a mobile communications system capable of handover from an active network

(communication system 19) with which the user equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising means for transmitting from the User equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65). But, Van Den Heuvel does not particularly show means for receiving a first list having a plurality of unique network identifiers; and means for storing a second list of available other networks supplied by the active network, means for comparing the received first list with a second list which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment for selectively communicating with at least one of a plurality of networks; means for updating the second list of available other networks based on information supplied by the active network. However in analogous art, Bridges teaches means for receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29), means for storing a second list of available other networks supplied by the active network (col. 15, lines 35-45), means for comparing the received first list with a second list (fig. 2C, "PSL/IRDB") which includes at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment (see col. 8, lines 50-67) for selectively communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); means for updating the second list of available other networks based on information supplied by the active network (col. 15, lines 35-45); therefore, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 20, Van Den Heuvel and Bridges disclose the User equipment according to claim 18. Bridges further discloses that comprising means for storing network preference information (col. 15, lines 35-45).

c) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. and Bridges in view of Chang (US-6,272,315).

Regarding claim 5, Tiedemann, Jr. and Bridges disclose the method according to claim 3. But, Tiedemann, Jr. and Bridges do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. and Bridges as taught by Chang Heuvel for purpose of providing the user with the most needed information of the available networks in order to increase significantly the efficiency of wireless communication service.

d) Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel in view of Bridges and further in view of Chang (US-6,272,315).

Regarding claim 8, Van Den Heuvel discloses a method (fig. 1 and col. 50-65) of operating the User equipment capable of handover between an active network (communication system 19) and another network (UMTS 14) comprising a stored list of available networks based on information supplied by the active network with which the User equipment is in communication (col. 2, lines 54-55 and also see cols. 3-4).

But, Van Den Heuvel does not particularly show receiving a first list having a plurality of unique network identifiers, storing a preference for a network in a second list having at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment; comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches receiving a first list having a plurality of unique network identifiers (col. 12, lines 66-67 and col. 13, lines 34-38; for more details see cols. 11-15 and 25-29), storing a preference for a network in a second list (fig. 2C, "PSL/IRDB") having the at least one unique network identifier from the plurality of unique network identifiers and is internally stored in the User equipment (fig. 2C, "PSL/IRDB"); comparing (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6) the received first list with the second list which includes at least one unique network identifier for selectively

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communicating with at least one of a plurality of networks (col. 6, line 53-col. 7, line 5 and/or inherently for "the mobile may select the most appropriate system for that region", see col. 12, lines 1-6); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-7).

But, Van Den Heuvel and Bridges do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel and Bridges as taught by Chang for purpose of offering the user with the most needed information of the available networks in order to provide the most efficient wireless communication service.

Regarding claim 9, Van Den Heuvel, Bridges and Chang disclose method of claim 8. Van Den Heuvel further discloses a step of signaling to the active network (communication system 19) with which the User equipment is in communication a preferred other network (UMTS 14) for handover (col. 1, lines 50-65 and also see cols. 3-4).

Regarding claim 10, Van Den Heuvel, Bridges and Chang disclose method of claim 9. Van Den Heuvel further discloses wherein said preferred other network is selected by the User equipment from a list of available networks supplied by the network (col. 1, lines 50-65).

e) Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel and Bridges in view of Gourgue (US-6,584,116).

Regarding claim 21, Van Den Heuvel and Bridges disclose the User equipment according to claim 16. But, Van Den Heuvel and Bridges do not particularly show wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. However in analogous art, Gourgue teaches wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks (col. 2, lines 15-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel and Bridges as taught by Gourgue for purpose of allowing the User equipment with capability continuously communicating while moving from UMTS network to GSM network.

Conclusion

7. THIS ACTION IS MADE FINAL.

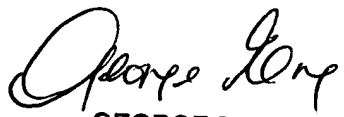
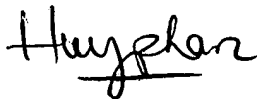
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE ENG
SUPERVISORY PATENT EXAMINER

Examiner: Phan, Huy Q.

AU: 2617

Date: 09/06/2006